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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/295,850    04/21/99    YDD

G    U012218-7

IM62/0428

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NEW YORK NY 10023

EXAMINER

MCBRIDE, R

ART UNIT

PAPER NUMBER

1731

DATE MAILED:

04/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/295,850

Applicant(s)

Yoo

Examiner

Rob McBride

Group Art Unit

1731



☒ Responsive to communication(s) filed on Apr 21, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-3 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Objections*

1. Claim 1 is objected to because of the following informalities: Claim 1 recites "periila". It appears as if the proper spelling is --perilla--. Appropriate correction is required.
2. The disclosure is objected to because of the following informalities: Page 1, line 17 recites "celluroses". Page 2, line 4 recites "take". The specification appears to be a translation and is replete with similar grammatical errors. Applicant is requested to check the entire specification for similar errors.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin in view of Webster's 3rd New International Dictionary, Finberg (US 2,930,719) and Horimoto (US 4,620,554). Shin discloses a tobacco substitute composition comprising Eucommia leaves, licorice, honey and peppermint mixture. Licorice reads on the claimed glycyrrhiza glabra in view of definitions found in Webster's 3rd New International Dictionary. Shin does not teach using

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licorice within the claimed range of 1-10%. Finberg teaches using licorice as flavourant in a casing material in a tobacco substitute at 4%. See column 3, line 70. It would have been obvious to one skilled in the art at the time of the invention to add the licorice to the tobacco substitute of Shin at 4% as taught by Finberg because it would accomplish no more than the expected result of flavoring the composition. Shin also does not teach adding 1-10% of *perilla frutescens*, also called Beefsteak according to Webster's 3rd New International Dictionary. Horihito teaches using Beefsteak, Japanese mint, peppermint and vanilla interchangeably as flavourants in a smoking composition from 1-10%. See column 1, lines 53-55. It would have been within the purview of one skilled in the art at the time of the invention to add a combination of beefsteak and Japanese mint as flavorants to the composition of Shin because Horihito teaches the aseptic action and tasteful properties of beefsteak (see column 2, lines 10-20) and the refreshing feel and taste properties of Japanese mint.

Regarding claim 2, Shin discloses a glycerol. See Abstract.

Regarding claim 3, Shin discloses using peppermint. Furthermore, Horihito discloses using peppermint in combination with beefsteak and Japanese mint within the claimed ranges.

See column 2, list 1.

5. *When filing a FAX in Group 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.*

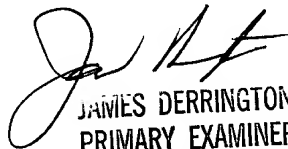
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*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert McBride whose telephone number is (703) 308-6366. The examiner can normally be reached on Monday-Friday between the hours of 9:00-3:00 PM (ET).*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stan Silverman, can be reached at (703)- 308-3837. The fax phone number for this group is (703) 305-7718.*

*Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose phone number is (703) 308-0651.*

  
JAMES DERRINGTON  
PRIMARY EXAMINER  
ART UNIT ~~137~~ 1731

rm  
April 13, 2000

**Robert E. McBride**  
**Patent Examiner**  
**Art Unit 1731**